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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,061	09/13/2002	John Geddes Erbes	24-NS-122726	2594

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EXAMINER

PALABRICA, RICARDO J

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/065,061

Applicant(s)

ERBES, JOHN GEDDES

Examiner

Rick Palabrica

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/19/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

1. Applicant's election with traverse of Group I (Apparatus), for which claims 1-12 are readable, is acknowledged.

2. Applicant's traversal of the election requirement was on the grounds that the alternative process cited by the examiner for use of the claimed apparatus (jet pump with support wedge) is not materially different from the process claimed by the applicant. This is unconvincing because the non-nuclear application cited by the examiner is materially different from the nuclear application of the claimed invention.

Applicant also alleged that a search and examination of all claims would not place a serious burden on the examiner. This reason is also not found persuasive because the individual searches for Groups I and II would not be co-extensive.

The restriction requirement is still deemed proper and is therefore made **FINAL**.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

***Specification***

3. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description of the invention and as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

The claimed invention is a wedge apparatus for a nuclear reactor jet pump. However, there is no adequate or enabling disclosure of how such could be accomplished using the applicant's invention.

On page 6, paragraph 0024, the applicant discloses the wedge apparatus based on Fig. 4. In the third sentence, it is recited that the first and second wedge segments are joined at the first end portions. In the next sentence, it is recited that these segments are joined at the second end portions. The disclosure is non-enabling for this recited configuration because: a) the recited configuration is inconsistent with Fig. 4; b) if the segments are joined both at the first and second end portions, then there will be no U-shaped body or slot 96 as recited in said paragraph.

Claims 1 and 6 suffer from the same inconsistency as above.

***Claim Rejections - 35 USC § 112***

4. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification in section 3 above.

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5. Claims 1-12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 6 recite the limitation "said joined second end portions" in lines 9 and 14, respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim 12 recites the limitation "said set screw" in line 2. There is insufficient antecedent basis for this limitation in the claims. Note that a set screw has not been recited as being part of any of the previously recited structures. Note further that the wherein clause raises a question as to the limiting effect of the language therein on the claims. It is unclear: a) whether or not the set screw is being claimed; and b) whether the segments are already deformed or can be deformed around the set screw. See MPEP 2106.II.C.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of Wivagg (U.S. 6,463,114) or Erbes et al. (U.S. 6,052,425).

Wivagg discloses a wedge apparatus for a BWR jet pump in Figs. 6-9, comprising a first tapered wedge segment having a first and second end portions (51), second tapered wedge segment having a first and second end portions (52). These segments are joined at the top end through lug structure 54 having a bore therethrough. There is a slot defined by an area between the first end portions and the joined second portions. The longitudinal axes of the first and second segments are substantially parallel to each other.

The jet pump elements of inlet mixer, diffuser and restrainer bracket are inherent in Wivagg's apparatus. Applicant's claim language "notch" reads on "chamfered side " 57 of Wivagg.

The claims are replete with statements that are either essentially method limitations or statements of intended or desired use. For example, "for a jet pump in a nuclear reactor", "engagable with said inlet mixer", "positioned between said restrainer bracket and said inlet mixer", "to receive a restrainer bracket set screw", "deformable around said set screw", are rotated with respect to each other along a longitudinal axis of said apparatus", etc. These clauses, as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference, as long as the structure of the cited references is capable of performing the intended use. See MPEP 2111-2115.

See also MPEP 2114 that states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus

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teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531.

[A]pparatus claims cover what a device is, not what a device does.”  
Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

The apparatus in the cited reference is capable of functioning in the same manner and for the same intended or desired use as the claimed invention. Note that as to claim 11, the apparatus in said reference is capable of being “sized to receive a restrainer bracket set screw.” Note that the slot can always be adjusted to a size capable of “receiving”, i.e., able to enclose a setscrew. As to claim 12, the apparatus is also capable of being deformable around a setscrew. Note that any metal structure that is forced to grip another structure, such as a metal screw, inherently suffers some deformation.

Applicant’s claim language reads on the embodiment in Figs. 3 and 4 of Erbes et al. (‘425). Note wedge structure 36 having first and second tapered segments (elements 38) joined at the second end, and they form a U-shape. There is a lug with a bore, i.e., screw opening 54 shown in Fig. 4. There is a notch in the first end portions of the segments (see notch above structure 52 in Fig. 4. As to the limitations in claims 11 and 12, see discussion on Wivagg above.

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Applicant's claim language reads on the embodiment in Figs. 3 and 4 of Erbes et al. ('433).

Note that claims 1-5 are so broad that they are readable on diverse prior art, including non-nuclear art, such as Akopov (U.S. 5,059,214), Karavidas (6,013,088), Chen (U.S. 5,876,026), Canard (U.S. 5,767,416), Reiter (U.S. 3,779,108), Wivagg et al. (U.S. 6,320,923), Weems et al. (U.S. 5,964,029), or Force et al. (U.S. 4,714,229).

7. Claims 6, 8-11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii (JP 10-311893), who discloses a jet pump riser support device. Said claims read on the embodiments in Figs. 3 and 5. Applicant's claim language reads on Ishii's apparatus as follows: a) "piping support wedge" reads on riser support device; b) "notch" reads on chamfered ends of the device. See section 6 for statements of intended or desired use and method limitations.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reference J further illustrates prior art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 703-306-5756. The examiner can normally be reached on 7:00-4:30, Mon-Fri; 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703-306-4198. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

RJP  
March 19, 2003

n-7C  
EXHIBIT 10/065,061  
CURRENT/SCOTT/10/065,061